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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,933	01/15/2004	Thomas W. Lanni	306168 81088	6526

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EXAMINER

CAVALLARI, DANIEL J

ART UNIT	PAPER NUMBER
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2836

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/758,933	Applicant(s) LANNI, THOMAS W.	
	Examiner Daniel J. Cavallari	Art Unit 2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The use of the trademark "emPower" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 8, 18, 28, & 39 are objected to because of the following informalities:

Claim 8 recites the limitation "the component" however "a component" is not previously disclosed. There is insufficient antecedent basis for this limitation in the claim. The claims will be examined as best understood to mean, "a component".

Appropriate correction is required.

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

The examiner notes that the applicant begins using reference characters appropriately (ie. "Vout" "Vref" "Vdata") placing them in parentheses but then precedes to use the reference characters in the claims improperly. Any characters or text in parentheses are not considered actual limitations of the claim therefore the reference characters should not be solely used in the claim rather the complete name of the component should be used (ie. "Vout" = regulated DC voltage, "Vref" = reference voltage, "Vdata" = data signal).

Appropriate action is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 14, 15, 24, 25, 34, & 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 14, 24, & 34 recite "emPower" which is a registered trademark therefore the use of "emPower" in the claims is improper.

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If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Appropriate action is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-13, 16-23, 26-33 & 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Atkinson et al. (US 2005/0127758).

Atkinson et al. (hereinafter referred to as Atkinson) teaches:

In regard to Claims 1, 9, 10, 11, 19, 20, 21, 29, 30, 31, 36, & 40

- A DC to DC adapter to receive DC power from a DC power source (127) and output a regulated DC voltage via controller (108) to devices (102, 104, 106, 108) (See Figure 1 & Paragraphs 7-9).

- Source determination circuitry (114) to receive the DC power from the DC power source (127) and compare a magnitude of a voltage of the DC power with a reference magnitude of a reference voltage (124) with comparator (114) (See Figure 1 & Paragraph 10).
- Wherein when the magnitude of the voltage of the DC power is greater than a reference magnitude, a data signal having a first value is output (via line 130) and when the magnitude of the voltage of the DC power is less than the reference magnitude, the data signal has a second value wherein the data signal is received by control circuitry (109) (See Figure 1 & Paragraph 10).
- When the data signal has the first value, the electronic device operates in a first mode (battery not charging) and when the data signal has the second value, the battery charging circuitry (110) is enabled (See Figure 1 & Paragraph 17).

In regard to Claims 2, 3, 12, 13, 22, 23, 32, & 33

- Wherein the DC power source (127) is an automobile cigarette lighter outlet, the magnitude of the DC power (11.0-14.1V) being less than the reference magnitude (14.5V) (See Figure 1 & Paragraph 12).

In regard to Claims 6, 16, 26, & 37

- The adapter further comprising an AC to DC adapter (122) (See Figure 1 & Paragraph 8).

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In regard to Claims 7, 17, 27, & 38

- Wherein the electronic device is a notebook computer (See Paragraph 8).

In regard to Claims 8, 18, 28, & 39

- The component being a battery (112) of the electronic device (See Figure 1 & Paragraph 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 14, 15, 24, 25, 34, & 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. and applicant's admitted prior art.

Atkinson teaches powering the adapter via an airplane provided electrical outlet wherein the reference voltage (14.5V) is less than the airplane voltage (See Paragraphs 1 & 11) however fails to explicitly teach an "empower airplane outlet". However, applicant's own admitted prior art (See Specification, Pages 1-2) teaches the empower power supply system used in airplanes which provides passengers with access to a DC power supply with a voltage of 14.5-15.5 VDC.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the airplane power supply by an empower DC power supply as taught by the applicant's admitted prior art. The motivation would have been to provide a standard and well known power supply in which to accommodate the power connection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Cavallari whose telephone number is (571)272-8541. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571)272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Daniel Cavallari

September 22, 2006